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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

PHAN, THIEM D

ART UNIT PAPER NUMBER

3729

DATE MAILED: 02/10/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/069,450

Applicant(s)

KARL, MARTIN

CS

Examiner

Tim Phan

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities:

- On page 1, before “Prior Art”, insert:

“Cross Reference to Related Documents

This application is a 371 of PCT/DE01/00497, filed February 9th 2001, which claims the benefit of Germany Patent Applications: No. 100 09 053.2, filed February 28th 2000 and No. 100 30 353.6, filed June 21st 2000.”;

- The attempt to incorporate subject matter into this application by reference to the Claim (Cf. Specification, page 1, line 25 and page 2, line 7) is improper because a cancellation or renumbering of the Claim will render the disclosure awkward and confused;
- On page 5, line 19, delete one “26”.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, because the claims are written in such a fashion that they are not active verbs and therefore the metes and bounds of the claimed invention is difficult, if not impossible, to determine. For example: in claim 1 "... is brought to ..." (line 2), "... is reshaped ..." (line 3), "... is reached ..." (line 4); in claim 3 "... is carried out ..." (line 2); in claim 4 "... is terminated ...", etc ... are not in a form which clearly delineates the scope of the claims in U.S. Patent practice. See also similar language in claims 4-9, i.e. each of the examined method and apparatus claims.

Claim 8 recites the limitation "the same machine tool" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Applicant is hereby noticed that the claims will not survive another rejection under 35 U.S.C. 112, 2nd paragraph. Applicant would do well if they carefully review and rewrite each of the claims 1-9 with the view of using positive, active language in order to properly claim any patentable subject matter.

4. Claim 9 is further rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

The apparatus claim, Claim 9, is written in such a manner so that it produces merely a catalogue of unrelated parts. In other words, the recited apparatus is non-functional.

Also the term "actively connected" in claim 9, line 3, is confused and vague. It is unclear whether the worm gear is connected, disconnected then reconnected to the drive motor.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3, 5, 9 and 14, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Oyafuso et al (US 5,971,621) hereinafter '621.

As applied to claims 1 and 3, the '621 teaches a process of axial adjustment of motor armature and shaft assembly, comprising the step of pressing the motor drive shaft (Cf. fig. 3A, element 52) to a nominal dimension or desired position where the thrust is reshaping the shaft (Cf. Fig. 3A, element 40) that is burnishing and renders smooth during forward movement toward a reached nominal dimension or desired position (Cf. Fig. 3A-3D).

As applied to claim 2, the '621 teaches that the material displacement (Cf. fig. 3A, element 40) is near one end of the shaft.

As applied to claim 5, the '621 teaches that the shaft is mounted on an electric motor (Cf. fig. 2, element 10) during insertion that renders material displacement (Cf. Fig. 3A-3D, element 40).

As applied to claim 9, the '621 teaches that a motor armature assembly, comprising:

- a drive motor (Cf. fig. 2, element 10);
- an armature shaft (Cf. Fig. 2, element 20);
- a gear (Cf. Fig. 1, element 14) where a worm gear (Cf. Fig. 2, element 12) which is attached to the motor through the shaft is coupled to at a specified nominal dimension or position by means of material displacement (Cf. Fig. 3A-3D, element 40).

As applied to claim 14, the '621 teaches that the material displacement has the shape of a circular ring (Cf. Fig. 4A, element 40).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 4, 6-8 and 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over the '621.

As applied to claims 4 and 6, the '621 teaches the claimed invention including the termination of the material displacement (Cf. Fig. 3D, element 40) when the specified nominal dimension for the desired position is reached, except for measuring the length of the shaft or part of it.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to measure the length of the shaft or part of it since it was known in the art that the desired position in the shaft which is reached is measured, recorded and calculated.

As applied to claim 7, the '621 teaches the claimed invention including the termination of the material displacement (Cf. Fig. 3D, element 40) when the specified nominal dimension for the desired position is reached.

As applied to claim 8, the '621 teaches the claimed invention including the endless screw (Cf. Fig. 2, element 12) that is created on the shaft as well as the displacement area (Cf. Fig. 2, element 30) except for having them created simultaneously or afterward by a same machine tool.

It would have been a mere matter of design choice to create the shaft as well as the displacement area (Cf. Fig. 2, element 30) simultaneously or afterward by a same machine tool.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to realize that the end play set value is reached since the shaft is axially locked when the desired position of the shaft that is thrust in is reached.

As applied to claim 10, the '621 teaches that the displacement material lies near the end of the shaft (Cf. Fig. 2, element 30).

As applied to claims 11-13, the '621 teaches a motor armature assembly which reads on applicant's claimed invention with the cross-sectional of the material displacement as a full circle (Cf. Fig. 3A, element 40).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the cross-sectional of the material displacement as semi-circular, trapezoidal, rectangular or any size that reduces the shaft diameter by up to one-half since it was known in the art that the thrust against the shaft (Cf. Fig. 3A, element 52) will move the material displacement.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tim Phan whose telephone number is 703-605-0707. The examiner can normally be reached on M - F, 9AM - 5PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 703-308-1789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.



Tim Phan
Examiner
Art Unit 3729


CARL J. ARBES
PRIMARY EXAMINER

tp
February 5, 2004